REMARKS

The applicants have studied the Office Action dated August 12, 2004. It is submitted that the application is in condition for allowance. Claims 15, 30, 32, 46 and 49 have been amended and claims 1-14, 16-29, 31, 39, 40-45, 48-58, 67-68 have been canceled without prejudice or disclaimer. Claim 66 has been added. Reconsideration and allowance of all of the claims in view of the following remarks are respectfully requested.

The Examiner objected to claim 66. Claim 66 has been added.

Claims 1-4, 10-14, 17, 19-25, 40-46 56 and 58-59 were rejected under 35 U.S. C. 102(b) as being anticipated by Masao JP 11015498.

Claims 7, 18, 29, 31 and 47 are rejected uner 35 U.S. C. 103(a) as being unpatentable over Masao.

Claims 5, 68-74 were rejected under 35 U.S.C. 103(a) as being unpatentable over Masao as applied to claims 1, 41 below, and further in view of Nordenstrom US 5, 668,868.

Claims 8-9, 15-16, 26-27, 30, 39, 48-54, 57 and 67 were rejected under 35 U.S.C. 103(a) as being unpatentable over Masao as applied to claims 1, 41 and/or claims 69 below, and further in view of McLoughlin et al. GB 2,343,822. These rejections are respectfully traversed.

Claim 15 recites "wherein the at least one criterion is variance from a pre-determined normal value." Claim 30 recites "wherein said adjustor runs the audio signal through free-form voice modification filtering to heighten understandability and reduce variance from the at least one stored recognition template." The references cited by the Examiner do not disclose a criterion of variance from a pre-determined normal value and reducing variance from the at least one stored recognition template. The Masao reference discloses transforming the transmitter's voice color into selected utterer's voice color, but does not disclose a criterion of variance from a pre-determined normal value and reducing variance from the at least one stored recognition template, as recited in the claims. The other references do not address the deficiencies of the Masao reference.

Claim 46 recites "the user receiving the at least one result of said comparing by providing of feedback to the user, the feedback being of at least one result of said comparing." Claim 59 recites "wherein said evaluating comprises statistically comparing, and assigning a percent variance of the audio signal from the stored recognition template." The references cited by the

Examiner do not disclose a step of a user receiving at least one result of comparing by being provided a feedback to the user and an evaluation that comprises statistically comparing, and assigning a percent variance of the audio signal from the stored recognition template.

Also, as admitted by the Examiner, the Masao reference does not disclose the steps of:

recording an audio signal;

playing back the audio signal to a user of the wireless device;

playing back the filtered audio signal to the user.

The Examiner states that the Nordenstrom reference discloses the above steps and has issued a 35 U.S.C. 103(a) rejection. *(see page 9 of the Office Action).* However, the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

> "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

Moreover, there must be some motivation or suggestion in the prior art to come up with the claimed invention. For example, the Court in In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983) declared:

> "The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings."

The Masao reference does not suggest the steps of recording an audio signal; playing back the audio signal to a user of the wireless device; and playing back the filtered audio signal to the user. Without the teaching or suggestion of such steps, it is respectfully submitted that the Examiner is engaging in hindsight reconstruction of the claimed invention. The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). Thus, it is clear that the Examiner is relying on impermissible hindsight to avoid express limitations in the claims and come up with unsupported and hypothetical teachings to thereby recreate the applicants' claimed invention.

Therefore, it is respectfully submitted that the rejection of claims 15, 30, 46, 59, 69 and their dependent claims under 35 U.S.C. §§102(b) and 103(a) should be withdrawn.

The applicant thanks the Examiner for allowing claims 32-38 and 60-66.

In view of the foregoing, it is respectfully submitted that the application and all of the claims are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested

If there are any fees due in connection with the filing of this response, please charge such fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for, such an extension is requested and the fee should also be charged to our Deposit Account. A duplicate copy of this page is enclosed.

Respectfully submitted,

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